

## REMARKS/ARGUMENTS

Applicants have studied the Office Action dated October 22, 2008. It is submitted that the application is in condition for allowance. Claims 1-10, 17, 18, and 21-32 are pending in the application. Claims 1-10, 17, 18, and 21-32 have been rejected. Claims 11-16, 19, and 20 have been previously cancelled. Reconsideration and allowance of the pending claims in view of the following remarks is respectfully requested.

In the Office Action, the Examiner:

- (1) withdrew the finality of the previous Office action and entered applicants' request for continued examination;
- (2) rejected claims 1, 2, 4, 17, 18, 21-23, 25, and 32 under 35 U.S.C. § 102(b) as being anticipated by Yoon (U.S. 5,620,452);
- (3-5) rejected claims 3, 7, 24, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Yoon (U.S. 5,620,452) in view of Nakao et al (U.S. 5,222,961); and
- (6) rejected claims 5, 6, 8-10, 26, 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Yoon (U.S. 5,620,452) in view of Nakao et al (U.S. 5,222,961), and in further view of Barrows et al (U.S. 4,719,917).

### (2) Rejection under 35 U.S.C. §102(b) Yoon

As noted above, the Examiner rejected claims 1, 2, 4, 17, 18, 21-23, 25, and 32 under 35 U.S.C. § 102(b) as being anticipated by Yoon (U.S. 5,620,452). The claims have not been amended to overcome the cited prior art.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Independent claims 1 and 22 recite, *inter alia*:

a first arm;  
a second arm substantially parallel to said first arm;  
a bridge connecting said first and second arms to form a  
**substantially static U-shaped structure retaining the shape prior  
to, throughout, and subsequent to application;**

...  
said retainer has a length in said direction of at least approximately  $\Pi$  times the distance between the arms when the arms are substantially parallel.

(Emphasis added)

Independent claim 17 recites, *inter alia*:

said at least one surgical clip comprises a first arm, a second arm substantially parallel to said first arm, a bridge connecting said first and second arms to form a **substantially static U-shaped structure** retaining the shape prior to, throughout, and subsequent to application

...

wherein said retainer has a length of at least approximately  $\Pi$  times the distance between the arms when the arms are substantially parallel.

Independent claim 21 recites, *inter alia*:

a bridge connecting said first and second arms to form a **substantially static U-shaped structure** with said first and second arms being substantially parallel to one another prior to, throughout, and subsequent to application

...

said retainer having a length in said direction equal to a multiple of a distance between said arms, said multiple being greater than 2.5.

Independent claim 32 recites, *inter alia*:

a bridge connecting said first and second arms to form a **substantially static U-shaped structure** with said first and second arms being substantially parallel to one another and being physically separated from one another when substantially parallel to one another prior to, throughout, and subsequent to application

...

said retainer having a length in said direction equal to a multiple of a distance between said arms, said multiple being greater than 2.5.

The present invention concerns a surgical clip inserted by a clip applier after the clip applier jaws grasp and puncture the invaginated fundus. The tissue is plicated and the retainer and arms are caused to slide over the tissue for a distance. **Then, only the retainer portion of the surgical clip is plastically deformed to affix the clip to the**

**fundus** (shown in Fig. 13 below). The claims, as written, provide that a property of the connecting bridge is that its stiffness retains the two parallel arms in the U-shaped form **prior to, throughout, and subsequent to** application. The bridge secures the arm elements in a **static** position throughout the entire application. It is only the deformable retainer at the end of one or both of the arms that is/are designed to deform plastically.

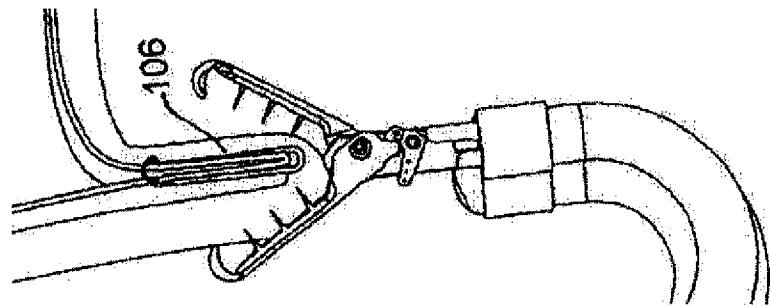


FIG. 13

The Examiner, on page 2 of the above-identified Office action, points to FIG. 10 of Yoon in an attempt to show anticipation of the present invention. The Yoon reference discloses a surgical clip, which is shown in FIG. 10 (placed below for convenience), "with a rounded or semicircular base 14 and staples 40 mounted on both the upper and lower arms 16 and 18 with tissue penetrating legs 50 positioned opposite apertures 36 formed in the other arm. ... the clip shown in FIG. 10 will have plastically shaped or deformed legs ...." Yoon, col. 4, lines 49-59.

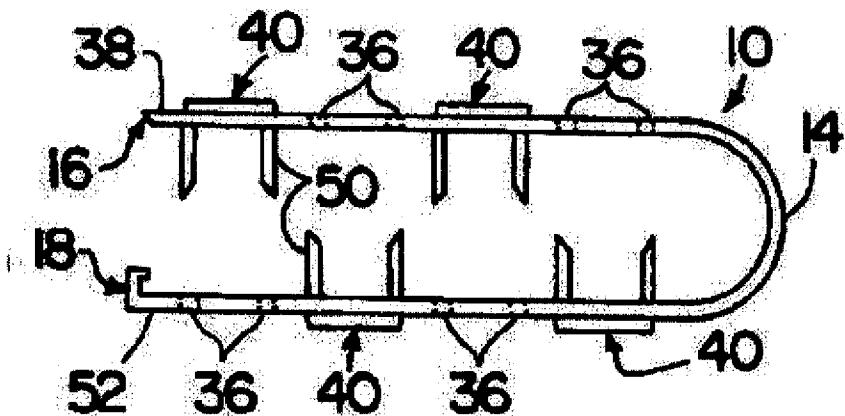


FIG. 10

The Examiner correctly states that a bridge in this single embodiment of Yoon resembles a U-shaped structure. However, Applicants respectfully submit that, in addition to the quoted section from Yoon in the directly-preceding paragraph, the Examiner's own statements illuminate the deficiency of this anticipation rejection. In the second item 2 on page 1 of the Office action, the Examiner states that "the length of the retainer is fully capable of being at least 3.14 times the distance between the arms when the arms are substantially parallel (**depending on how far the hashed line is manipulated**)."  
(Emphasis added.) However, if the Yoon clip must be manipulated to meet this recitation of the claims of the instant application, then, by definition, Yoon cannot also be "a substantially **static** U-shaped structure," as the claims of the instant application also recite.

As shown in FIG. 10 above, Yoon's staples 40 mounted on the upper and lower arms 16 and 18 are in opposition to corresponding apertures 36 formed in the lower and upper arms 18 and 16. Yoon, col. 4, lines 42-46. These corresponding areas 36 & 40 show that the upper and lower arms are designed to meet each other or at least approach each other during application of the clip. If the arms were moved to where staples 40 were at least 3.14 times the distance between the arms when the arms are substantially parallel, the bridge section of Yoon would no longer resemble a U-shape, but would be a V-shape, as is shown in all of the other illustrated embodiments of Yoon.

In addition, Yoon's own description of the embodiment of FIG. 10 being "plastically shaped or deformed legs" **is in direct opposition** to "a first arm...a second arm...and a bridge connecting said first and second arms to form a substantially **static** U-shaped structure retaining the shape prior to, throughout, and subsequent to application" as recited in the independent claims of the instant application.

Furthermore, on page 2 of the instant Office action, the Examiner notes that the amount of separation between the two arms merely depends on the amount of force used to press the arms together. Again, the Examiner's own statements support the applicants' position stated above. That is, the Examiner acknowledges his understanding that the

Yoon clip is not static and that the arm separation is dependent upon the force used to press the arms together and that the bridge is not able to “connect[] said first and second arms to form a substantially **static** U-shaped structure.” Based on the Examiner’s interpretation alone, it is clear that **Yoon discloses a clip that only functions if the arms are moved together during normal operation (i.e., they are deformable, non-static) so that the apertures 36 and staple 40 intersect with each other.** In stark contrast, the arms of the present invention remain “**static**” prior to, throughout, and subsequent to application. Also, Yoon would not function to allow tissue in between the arms if the staples were “at least at least 3.14 times the distance between the arms when the arms are substantially parallel.”

The Examiner cites 35 U.S.C. § 102(b) and a proper rejection requires that a single reference teach (i.e., identically describe) each and every element of the rejected claims as being anticipated by Yoon.<sup>1</sup> Because the elements in independent claims 1, 17, 21, 22, and 32 of the instant application are not taught or disclosed by Yoon, the apparatus of Yoon does not anticipate the present invention. The dependent claims are believed to be patentable as well because they all are ultimately dependent on either claim 1, 17, 21, 22, or 32. Accordingly, the present invention distinguishes over Yoon for at least this reason. The Applicants respectfully submit that the Examiner’s rejection under 35 U.S.C. § 102(b) has been overcome.

(3-5) Rejection under 35 U.S.C. §103(a) Yoon in view of Nakao et al.

As noted above, the Examiner rejected claims 3, 7, 24, and 28 under 35 U.S.C. § 103(a) as being unpatentable over Yoon (U.S. 5,620,452) in view of Nakao et al. (U.S. 5,222,961).

The Examiner attempts to combine Yoon in further view of Nakao et al. to sustain an obviousness rejection. The arguments set forth above in section “(2) Rejection under

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<sup>1</sup> See MPEP §2131 (Emphasis Added) “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the ... claim.”

35 U.S.C. §102(b) Yoon" are incorporated herein. Claims 3 and 7 depend directly from independent claim 1 and claims 24 and 28 depend from independent claim 22. Independent claims 1 and 22 distinguish over Yoon. Since dependent claims contain all the limitations of the independent claims, claims 3, 7, 24, and 28 distinguish over Yoon, as well.

Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Nakao et al. reference as applied to claims 3, 7, 24, and 28. Nor is it necessary to address whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Yoon reference, as required by MPEP § 2143. As such, Applicants respectfully request that the Examiner's rejection of claims 3, 7, 24, and 28 be withdrawn.

(6) Rejection under 35 U.S.C. §103(a) Yoon in view of Nakao et al. and Barrows et al.  
As noted above, the Examiner rejected claims 5, 6, 8-10, 26, 27, and 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Yoon (U.S. 5,620,452) in view of Nakao et al. (U.S. 5,222,961), and in further view of Barrows et al. (U.S. 4,719,917).

The Examiner attempts to combine Yoon view of Nakao et al, in further view of Barrows et al to sustain an obviousness rejection. The arguments set forth above in section "(2) Rejection under 35 U.S.C. §102(b) Yoon" are incorporated herein. Claims 5, 6, and 8-10 depend directly from independent claim 1 and claims 26, 27, and 29-31 depend directly from independent claim 22. Independent claims 1 and 22 distinguish over Yoon. Since dependent claims contain all the limitations of the independent claims, claims 5, 6, 8-10, 26, 27, and 29-31 distinguish over Yoon, as well.

Accordingly, the Applicants respectfully submit that it is not necessary at this stage to address the Nakao et al. and Barrows et al. references as applied to claims 3, 7, 24, and 28. Nor is it necessary to address whether or not there is sufficient suggestion or motivation with a reasonable expectation of success for modifying the Yoon reference, as required by MPEP § 2143. As such, Applicants respectfully request that the

Examiner's rejection of claims 5, 6, 8-10, 26, 27, and 29-31 be withdrawn.

### **CONCLUSION**

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

Applicants acknowledge the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicants and their attorneys.

Applicants respectfully submit that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

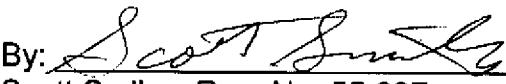
If an extension of time for this paper is required, petition for extension is herewith made.

It is believed that no fee is due with this Amendment. However, if any fees are due with respect to Sections 1.16 or 1.17, please charge to the deposit account of the undersigned firm, Acct. No. 503,836.

**PLEASE CALL** the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: January 22, 2009

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